

REMARKS

Status of the Claims

Claims 1-19 and 21 are currently pending in the application. Claims 1-19 and 21 stand rejected. Claims 1-7 and 9-18 have been amended without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendments to claims 1-7 and 9-18 are supported by the specification at, for instance, page 52, line 15 to page 57, line 1. Other amendments made to the claims are generally to remove terms from the claims, as discussed in more detail below. Reconsideration is respectfully requested.

Interview

Applicants and Applicants' representatives thank the Examiner for extending the courtesy of an interview on November 27, 2008. The substance of the interview is substantially as reflected in the Interview Summary of December 17, 2008.

Rejections Under the Obviousness-Type Double Patenting Doctrine

Claims 1-45 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-71 and 73-92 of Mizui et al., U.S. Patent No. 7,026,352, hereinafter referred to as "Mizui et al." (*See*, Office Action of December 17, 2007, at page 3, hereinafter, "Office Action" and prior Office Action of June 8, 2007, at pages 12-16).

Claims 20 and 22-45 have been cancelled, thereby obviating the rejection as to these claims. Although Applicants do not agree that the present claims are obvious in light of the

disclosure of Mizui et al., to expedite prosecution, Applicants submit herewith a Terminal Disclaimer, thus obviating the rejection as to the remaining pending claims.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-19 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See, Office Action, at pages 3-4). Applicants traverse the rejection as set forth herein.

The Examiner states that the term “substituent” recited in the claims, for example in claim 1, parts 1) through 5), is indefinite. The Examiner states that the term “substituent” as defined in the specification, at page 52, is broad and encompasses a large number of possibilities.

Although Applicants do not agree that the term “substituent” is indefinite, to expedite prosecution, the claims have been amended to recite, in part, “wherein said substituents are each independently selected from the group consisting of: C₁-C₆ alkyl group, phenyl group, halogen, hydroxyl group, C₁-C₆ alkoxy group, thiol group, C₁-C₆ alkylthio group, nitro group, nitroso group, cyano group, C₁-C₆ alkoxycarbonyl group, amino group, mono (C₁-C₆ alkyl) amino group, di (C₁-C₆ alkyl) amino group, pyrrolidyl group, piperadyl group, piperidyl group and pyridyl group.” Support for these amendments may be found in the present specification at, for instance, page 52, line 15 to page 57, line 1.

Therefore, reconsideration and withdrawal of the indefiniteness rejection of claims 1-19 and 21 are respectfully requested.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-19 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. (*See*, Office Action, at pages 4-15). Applicants traverse the rejection as set forth herein.

The Examiner states that the specification fairly enables one of skill in the art to practice the invention wherein the compound claimed is defined by R⁷ and R²¹, which are defined as: (1) O-benzyl, (2) OH, and (3) RC(=O)-O-, wherein R is piperazinyl, alkyl, -O-phenyl, -N-alkyl or -NH-phenyl. This conclusion was reached by the Examiner based on the support found at pages 105-132 of the specification.

Although Applicants do not agree that the present specification, in light of the knowledge of one of skill in the art, does not enable one of skill in the art to make and use all aspects of the presently claimed invention, to expedite prosecution, claims 1-18 have been amended to remove subject matter from the claims which the Examiner has indicated as lacking enablement. Applicants believe that the present claims, at least as amended, are fully enabled as indicated by the Examiner.

Reconsideration and withdrawal of the enablement rejection of claim 1-19 and 21 are respectfully requested.

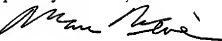
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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